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| 09/704,374      | 11/01/2000  | David L. Gilmour     | 003386.P016         | 5462             |

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03/29/2006

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EXAMINER

THOMPSON, MARC D

ART UNIT

PAPER NUMBER

2144

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                       |  |
|------------------------------|--------------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/704,374 | <b>Applicant(s)</b><br>GILMOUR ET AL. |  |
|                              | <b>Examiner</b><br>Marc D. Thompson  | <b>Art Unit</b><br>2144               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20020325, 20050801</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This application has been examined.
2. Claims 1-9 are pending.

#### ***Priority***

3. This application is a continuation-in-part of Application/Serial Number 09/270,974 (Filed 3/17/1999), now U.S. Patent Number 6,205,472, which is a continuation-in-part of Application/Serial Number 09/157,093 (Filed 9/18/1998), now U.S. Patent Number 6,154,783.
4. The effective filing date for the subject matter defined in the pending claims which is newly supported in this application is 11/1/2000.

#### ***Drawings***

5. The Examiner contends that the drawings submitted on 11/1/2000 are acceptable for examination proceedings.

#### ***Specification***

6. The specification is objected to for the following reasons:  
  
Page 2, Lines 4-6, recite related applications/priority claim(s) which fail to report current pending status, and the patent numbers which these documents have matured into, namely U.S. Patent Number 6,205,472, and 6,154,783, respectively.  
  
Correction is required.

***Information Disclosure Statements***

7. The IDS (PTO-1449) submitted on 3/25/2002 cites a huge amount of non-patent literature as submitted prior art, including dozens of single page “printouts” of web pages, undated.

Additionally, Applicant has submitted a mass of prior art along with this IDS statement, about 36 documents. However, the prior art submitted does not match the cited prior art citations on the PTO-1449. None of the web pages cited on the document are included in the submitted art, and the IDS does not cite any of the references actually submitted with the IDS. Lines have been stuck through the entries on this IDS in accordance with MPEP § 609.

8. Additionally, while some of the art looks peripherally pertinent, it is unclear what art the Applicant intended to have submitted and considered. That is, initial consideration of both the submitted art and citations appear to not all have direct relevancy or pertinence to the instant invention as claimed. Applicant is requested in response to this office action to point out which of these numerous prior art are pertinent or relevant to the patentability of the invention as claimed in this instant application, in addition to (re)submitting any art which is desired to be considered by the Examiner. It should be noted that it would be advantageous to the applicant to provide a concise explanation of why each of the prior art is being submitted and how it is understood to be relevant. “Concise explanations are helpful to the Office, particularly where documents are lengthy and complex and applicant is aware of a section that is highly relevant to patentability or where a large number of documents are submitted and applicant is aware that one or more are highly relevant to patentability.” (See MPEP 609 under subheading “A. CONTENT”).

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of United States Patent Number 6,205,472.

11. Although the conflicting claims are not identical, they are not patentably distinct from each other because the independent patented claims and the independent presented claims differ only with respect to the specification of a query expiration parameter for use in "retiring" queries. The provision for query expiration and query retiring is already claimed, inter alia, patented claim 15. The sole discernable difference is the provision for the use of parameter(s) for retiring queries as claimed, in regard to a second set of queries (present claims) as opposed to an initial query. Thus, the set of presented claims comprise a majority of subject matter which is expressly disclosed and claimed by Patent Number 6,205,472, and further, since the differences between the patented claims and the presented claims would have been an obvious variation of the patented invention, minimally based on the contained teachings, "duplication of parts", "rearrangement of parts", and potentially other rationale (see, inter alia, MPEP §2144.04).

12. Claims 1-9 are rejected.

***Claim Rejections - 35 USC § 101***

13. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

14. Claims 4-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

15. Claim 4 recites “data representing sequences of instructions” instead of reciting the sequences of instructions themselves. One of the broadest reasonable interpretations of this claim preamble includes data on a given medium (e.g., textual document or punch card) describing instructions which will (eventually, presumably) be executed on/by a processor (e.g., source code), which is held to be non-statutory.

16. It is noted that there is no antecedent basis for machine-readable medium in the specification, and so broadest reasonable interpretation dictates the metes and bounds of the usage of this term as known in the art. The term is being considered to encompass various optical and electro-magnetic mediums (such as CDROM, hard drives, floppy drives, etc.), but the inclusion of “carrier wave”, “signal bearing”, or other similar mediums are not considered included, since no indication of coverage drawn to the actual transport or conveyance of processor executable information over a transmission medium is reasonably drawn from the claims/specification.

17. For further guidance on these topics, please refer to the Official Gazette, dated 11/22/2005, found here:

<http://www.uspto.gov/web/offices/com/sol/og/2005/week47/og200547.htm>

***Claim Rejections - 35 USC § 112***

18. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

19. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

20. All claims recite "...the second query is retired" in the last words of the claim. When considering the intended meaning of this term in the claim, it is unclear what is attempting to be described. It is noted that use of the term "retired" is not clearly dictated in the specification to provide sufficient meaning to the use of this word as currently employed in the claim invention. The term "retired" further indicates "time" passing, as dictated in some of the claims (1-2, 4-5, and 7-8), but this fact is unclear in regard to the remaining claims. For purposes of claim construction, "...query is retired" will be interpreted to mean "...query is terminated".

21. Second, a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex*

*parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In the present instance, claims 1, 4, and 7, recite the broad recitation “query expiration parameter [which effects X]”, and dependent claims 2, 5, and 8, recite “query expiration interval [which effects X]” which is the narrower statement of the range/limitation. It is noted that these limitations perform identical functions as claimed.

22. Second, the limitation "specifying a query expiration parameter...after which the second query is retired" infers some direct definition of a time interval. Claims 3, 6, and 9, recite “wherein specifying a query expiration parameter comprises...specifying a maximum number of matches”, which does not relate to time intervals of any sort. Use of the term “after” renders claims 3, 6, and 9, indefinite, in combination with the narrow provisions for parameter types, due to the inability to discern what exactly is being claimed.

23. Lastly, it is unclear whether the last two lines of claims 1, 4, and 7, recite functionality which dictates (1) specifying a query explanation parameter and using it to (potentially) retire the second query, or (2) specifying a query explanation parameter and retiring the second query regardless of any functional usage of the parameter. For purposes of claim construction, the use of the parameter to determine query termination is presumed.

#### ***Allowable Subject Matter***

24. The claims recite provision for a first query accessing a public portion of a knowledge profile comprising terms defining the knowledge base of a potential target, effecting matching of query terms with these public knowledge terms to determine a set of potential targets which are



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published to the originator of the query. Next, responsive to a second query generated by the originator, comparing private knowledge terms comprising the private knowledge profiles of potential targets with the second query to determine a second set of targets based on the private knowledge terms. Then, there is a provision for prompting each member of the second set of targets for authorization to be published to the query originator. Finally, in combination with the above discussion, and the remainder of the claimed invention presently set forth, the provision for specification of a query expiration parameter, dictating a time interval or other condition when satisfied, which effects termination of the second query prior to completion, is not reasonably taught or suggested by the prior art of record. This functionality is supported by the present specification, inter alia, at Pages 6, Page 17, Line 7 through Page 18, Line 9, Page 25, Line 3 through Page 29, Line 18, Page 45, Line 12 through Page 55, Line 18, and Page 73, Line 18 through Page 74, Line 4, and all appropriate accompanying Figures.

### ***Conclusion***

25. Applicant is charged with clarification and correction of any information or statement(s) contained within this Office action which is deemed to be inaccurate. All information contained within is believed factual at the time of mailing.

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc D. Thompson whose telephone number is 571-272-3932. The examiner can normally be reached on Monday-Friday, 9am-4pm. If attempts to reach the

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Examiner by telephone are unsuccessful, the Examiner's supervisor, William Vaughn, Jr., can be reached at 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned has recently changed, and is now 571-273-8300.

28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit 2144